UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,444	07/31/2003	Scott R. Carrier	LOT920030006US1	2867

23550   7590   06/05/2007
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EXAMINER
LIN, WEN TAI

ART UNIT	PAPER NUMBER
2154	

MAIL DATE	DELIVERY MODE
06/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 August 2003</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-26</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-26</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>01 August 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/03</u>.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-26 are presented for examination.

2.   Claims 3, 16, 22 and 24-26 are objected to because the following terms lack
antecedent basis:

    in claim 3:   "the user data"

    in claim(s) 16 and 22:   "the electronic address"; and

    in claim 24:   "the validity system."

Claim Rejections – 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

3.   Claims 21-26 are rejected under 35 U.S.C. 101 because the claimed subject
matter appears to be software comprising a set of program codes. Note that the
language: "a program product stored on a recordable medium ... comprising ..."
indicates that the program product itself is not part of the recordable medium. For
purpose of overcoming the 101 rejection, Applicant is recommended to claim the
recordable medium that includes the listed program codes.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Stern et al.(hereafter "Stern")[U.S. PGPub 20020032740].

6.   Stern is cited from Applicant's IDS

7.   As to claims 1-2, Stern teaches the invention substantially as claimed including:

a method for automatically generating electronic addresses of users [e.g., paragraphs

69-73], comprising:

   providing a sequence of address generation scripts;

   determining a valid electronic address for a user by iterating through the

sequence of address generation scripts,

   wherein the valid electronic address is determined when one of the address

generation scripts produces an electronic address that is unique and complies with a

predetermined addressing standard [e.g., paragraphs 160-171; note that each

candidate or alternate variant of the email formation patterns in paragraphs 163-169 has

an inherent segment of codes implementing the respective formation method]; and

assigning the valid electronic address to the user [Fig.3].

Stern teaches that the address generation is for marketing purposes (i.e.,

addresses that already exist). does not specifically teach that the electronic addresses

are assigned to users (i.e., the addresses do not previously exist).

However, it would have been obvious to one of ordinary skill in the art that

Stern's method is also applicable to new email address generation because Stern's

reverse engineering method enables the address generation process to efficiently make

use of some of known employees' email addresses for discovery of a company's

general email address pattern to which a new employee's email address also needs to

conform [paragraphs 161-163].

8.   As to claim 3, Stern further teaches that the user data is provided from a

repository [e.g., paragraph 69 and claim 5; i.e., a database].

9.   As to claim 4, Stern further teaches that the determining step comprises:

        generating a first electronic address according to a first one of the sequence of

address generation scripts; and testing the first electronic address to determine if the

first address is unique [e.g., paragraph 66] and complies with a predetermined

addressing standard [e.g., paragraph 171].

10.   As to claims 5 and 7, Stern teaches using predetermined addressing standard to form the email addresses. Therefore the resulting addresses are inherently compliant with the intended standard.

Further, Stern teaches resolving duplicate information stored in the database in general. Stern does not specifically teach resolving duplicates by comparing the generated electronic address against those previously created electronic addresses and that the set of previously created electronic addresses are stored in an electronic address repository.

However, resolving duplicates by the aforementioned comparison method is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to test each of Stern generated email addresses by comparing newly generated address against the existing addressed and storing the previously created electronic addresses in an electronic address repository because the former is a popular and efficient approach to achieve uniqueness, while the latter facilitate access of the existing addresses when performing comparison.

11.   As to claim 6, Stern further teaches that the set of previously created electronic addresses are stored in a repository with user data corresponding to the user [e.g., claim 18].

12.   As to claims 8-26, since the features of these claims can also be found in claims

1-7, they are rejected for the same reasons set forth in the rejection of claims 1- 7

above.

13.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

      Hall   [U.S. PGPub 20020194308];

      MacIntosh et al.   [U.S. PGPub 20020138581];

      Malik   [U.S. PGPub 20020065891]; and

      Del   [U.S. PGPub 20040024823].

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the

references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are

applied to the specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested from the applicant in preparing

responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the contest of the passage as taught by the prior art

or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:
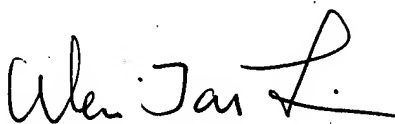
(571) 273-8300 for official communications; and

(571) 273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

May 29, 2007